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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,476	10/16/2003	Dan L. Adams	104-26964 (9010RF-045396)	7960

7590 05/26/2005

BRACEWELL & PATTERSON, L.L.P.

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Houston, TX 77208-1389

EXAMINER

JASTRZAB, KRISANNE MARIE

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,476

Applicant(s)

ADAMS, DAN L.

Examiner

Krisanne Jastrzab

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-20 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton U.S. patent No. 3,335,791 in view of Speed U.S. patent No. 4,462,758.

Patton teaches a submersible wellbore pump that is constructed having a housing with an intake and discharge passage and a rotary pump stage having a passage for well fluid flow. The pump includes an impeller and a diffuser. Patton teaches supplying a lubricant, which intrinsically coats the components of the pump, containing a biocide to prevent the growth of bacteria within the well housing and within the pump itself. See column 2, lines 20-25, lines 41-51 and lines 65-72, column 4, lines 14-45, and column 5, lines 52-60.

Speed teaches the recognized conventionality of submersible pumps provided with motors that are placed in the well along with the pump.

Patton teaches substantially the method as claimed, however, Patton performs the coating of the pump in situ, instead of prior to lowering into the well. It would have been well within the purview of one of ordinary skill in the art to fully lubricate and coat the pump prior to operation because it would ensure optimal coating of the pump components prior to wetting which could act to disrupt thorough coating. It would further have been well within the purview of one of ordinary skill in the art to employ the type of pump means with a submersible motor as well as impeller and diffuser because of their well recognized efficacy in the art as supported by Speed.

With respect to claims 28-29, it is noted that Patton teaches a single stage pump means, however it would have been well within the purview of one of ordinary skill in the art to utilize a multi-stage pump in lieu thereof, because the conventionality of such pumps is well recognized and because the additional stages would merely rise to a duplication of parts with the same function.

Claims 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Speed, as applied to claims 15-20 and 24-29 above, and further in view of McClaflin et al., U.S. patent No. 4,605,069.

McClaflin et al., teach the use of biocides with a wellbore pump, including gluteraldehyde. See column 4, lines 50-65. It would have been obvious to one of ordinary skill in the art to employ any known compatible biocide, such as gluteraldehyde as taught in McClaflin et al., within the method of Patton, because of the well

established efficacy of gluteraldehyde in sterilization procedures as well as it's compatibility within the wellbore environment.

Claims 22-23 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Speed and McClaflin et al., as applied to claims 21 and 30 above, and further in view of Byassee et al., U.S. patent No. 5,783,117.

Byassee et al., teaches inhibiting bacterial growth within a humidification system having a submersible pump means wherein the biocide included a zinc based biocide as well as a chlorine based biocide. The biocides are chosen for their compatibility with the water systems. See column 5, lines 15-35.

It would have been well within the purview of one of ordinary skill in the art to choose any known and expected biocide compatible with submersible pump water systems, included metal based biocides formed with zinc and chlorine base biocides.

### ***Response to Arguments***

Applicant's arguments with respect to claims 15-32 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that there would be no motivation in Patton to coat the pump components prior to insertion in the well, because there would be no guarantee of extended efficacy of that coating sustaining the biocide activity until the pump was removed for maintenance. However, the Examiner would note that the rejection does not assert that coating the parts prior to insertion would then exclude the continued application of the biocide containing lubricant during use of the pump, but on the contrary, pre-coating would just ensure actively lubricated parts at start up of the pump

and the in situ lubrication would continue as disclosed. The pre-coating would act as a preventative measure in lieu of a dry start up of the pump, it would not take the place of lubrication during use thereof.

Applicant further argues that neither McClafin nor Byassee et al., teach impeller type pump means, however, the Examiner would point out that neither of those references is relied upon for impeller pump teachings, but for their teachings setting forth the acceptable activity of certain biocides in submersible/well pump configurations.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

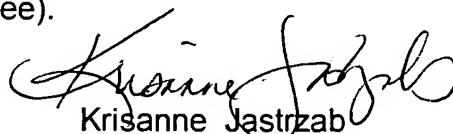
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-

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1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on 571-272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Krisanne Jastrzab  
Primary Examiner  
Art Unit 1744

May 25, 2005